

Appln No. 09/575,118  
Amdt. Dated June 22, 2004  
Response to Office Action of March 22, 2003

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### REMARKS/ARGUMENTS

#### Claims 47 to 60

Claim 47 stands rejected under 35 USC 103(a) as being obvious over Cass in view of LaMarca.

With respect, Applicant disagrees.

In Cass, a page is printed by a conventional printer providing only visible printed information. A user produces visible marks on the printed page using a conventional pen. The marked page is then scanned in its entirety and the location of any markings on the page are used as an indication of the selection of an active element.

It should be noted here that the term "active element" as used in Cass is vastly different to the term "interactive element" as used in the present application. In Cass, the printed "active elements" are in fact passive elements because the user is unable to interact with the computer system directly through the element printed on the page. Instead, Cass requires additional marks to be made on the page by a conventional pen. The computer system then interacts with the markings, not the originally printed active element.

The interaction with the markings first requires the page to be scanned so that the existence of the markings can be determined on an electronic copy of the document. Thus, in essence, it is only the markings on the electronic version of the page that are truly interactive with the computer system.

In the present application, the page includes coded data indicative of an interactive element so that a user may interact with a computer system by placing a sensing device into an operative position with respect to the coded data on the page. Thus, in the present application, the elements are truly and directly interactive.

Despite the above distinction, the following arguments are based on an interpretation that the described "active element", ie the element printed onto the page of the Cass system, is considered to be the interactive element described by the present application.

The Cass system differs from the present invention in that no coded data is printed onto the page, only plainly visible data is provided. The only coding of the page occurs in the electronic version of the page which is stored in the computer system. Thus, with reference to claim 47, Cass omits the features that

*"the surface having coded data indicative of an identity of the at least one user interactive element"*

and

*"receiving, in a computer system, indicating data from a sensing device, the indicating data indicative of the identity of a selected user interactive element, the sensing device, when placed operatively relative to the selected user interactive element, generating the indicating data based at least partially on sensing at least some of the coded data"*

*"causing the list of directory entries and the coded data to be printed onto the surface substantially simultaneously"*

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In order for Cass to read on present claim 47, the scanner of Cass must be considered to be the sensing device, because it is only the device that can be considered to be "*placed operatively relative to the selected user interactive element*" as claim 47 requires. However, the operation of the scanner is such that the scanner scans the page in its entirety and transmits an electronic version of the page to the computer system for further processing. The scanner does not itself sense any coded data, nor does the scanner generate and send to the computer system, any indicating data *indicative of the identity of a selected user interactive element*.

In Cass, a user selects an element by placing a mark on the page using a conventional pen. That an element has been selected is determined by comparing the scanned electronic copy of the page containing the markings, with an original copy of the page stored in the computer system.

The Examiner has stated that Cass teaches all of the features of claim 47 except that the coded data and the list of directory entries is printed substantially simultaneously. As demonstrated above, the Applicant respectfully submits that Cass omits more features of claim 47 than the Examiner has identified.

The Examiner has argued that the features of the present invention not taught by Cass can be found in the teachings of LaMarca. Examiner has stated, on page 3 of the Official Action, that LaMarca teaches identifying, using the indicative data, further directory information relating to the selected user interactive element and providing the further directory information to the user. For basis of the Examiner's submission, the Examiner has relied on col 5, lines 4-12 and 34-40, and Figures 1 and 2.

LaMarca teaches a user profile updating system. In a newspaper delivery system, dataglyphs, ie tokens, are provided in a newspaper for providing user preference data in respect of assorted content items, ie news articles. With respect, the passages of LaMarca identified by the Examiner describe this profile updating system and not a system of printing and navigating a list of directory entries as the Examiner contends. The tokens relate to user preferences such as indicating a user's rating of a movie for an opinion poll (column 4, lines 33-35) or indicating that news articles relating to certain subject matter are unwanted by the user (column 4, lines 20-25). By using a smart wand and operating the wand in conjunction with the appropriate token, the user is able to transmit the user's preferences to a central computer system where the user's preferences are updated and stored. Thus future editions of the newspaper that are provided to the user can be matched to the user's profile. There is no teaching or suggestion in LaMarca that the assorted content items include a "*list of directory entries corresponding to at least one node of an index of the directory*", as required by claim 47.

Thus, with respect, Applicant submits that those sections identified by the Examiner do not teach navigating a directory as described by the present application, nor does any other section of LaMarca.

Examiner has stated that LaMarca teaches providing coded data and the list of directory entries simultaneously. Whilst Applicant concedes that LaMarca does teach the simultaneous printing of the assorted content items and the associated tokens, ie dataglyphs, Applicant argues that the assorted content items are news articles and the like and are in no way related to the list of directory entries as required by the present application.

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Examiner has submitted that the person skilled in the art would be motivated to combine the teachings of Cass and LaMarca to arrive at the present invention. Applicant respectfully disagrees. The teaching or suggestion to combine the references must be found in the references themselves and must not be based on the applicant's disclosure, see MPEP §2143. To arrive at the present invention by the combined teachings of Cass and LaMarca would require some teaching or suggestion in either document that such a combination would be beneficial.

The Cass system provides a self contained system. The complete functionality of Cass is provided without the need for coded data to be printed onto the printed page. Therefore, looking from the point of view of Cass, the skilled addressee would not seek to add the teachings of LaMarca because Cass does not require the printing of coded data onto a page in order to enable the Cass invention, nor would such an addition to Cass be seen as beneficial.

Looking from the point of view of LaMarca, the person skilled in the art would not seek to add the teachings of Cass because there is no teaching or suggestion in LaMarca that the LaMarca system is suitable for directory navigation. In the absence of any such specific teaching in LaMarca, Applicant submits that the Examiner's contention of the skilled addressee's motivation has occurred using the hindsight of the present invention.

Examiner has provided sections from LaMarca that Examiner contends demonstrate a motivation for the skilled addressee to combine LaMarca with Cass. The passages of LaMarca quoted by the Examiner are largely concerned with the user profile updating aspects of LaMarca, the back channel communication of user preferences to a publisher on the relative interest of a selected items, and the applicability of the LaMarca system for newspaper publication. These aspects are irrelevant in regard to the directory navigation system of the present invention because the present invention is not based on user profiles or preferences.

Thus, Applicant respectfully submits that the extension of a user profile updating system for providing redacted copies of a newspaper or similar periodical publication in accordance with user preferences, to a directory navigation system of the type presently described, requires the hindsight of the present invention and that it would not have been obvious to the skilled addressee to add the teachings of Cass to the teachings of LaMarca.

Applicant further submits that whilst Cass and LaMarca both require printing technology, they would not both be categorized as printing technology per se. Cass is a system for directory navigation where documents are printed in a conventional manner, without coded data, where markings on a page are scanned in a conventional manner to determine any changes to the document, and for providing a new page based on the above described manner of selection. LaMarca is a system for receiving and updating a user profile database and is based on the use of pages having coded data. Applicant argues that these classes of invention are sufficiently removed from each other, with neither system being considered common general knowledge as at the relevant priority date, that it would not be obvious for the skilled addressee to combine the disclosures in the manner that the Examiner has suggested.

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In light of the above comments, Applicant submits with respect that claim 47 is allowable and that Examiner's rejection of claim 47 is hereby traversed. Applicant further submits that as claims 48 to 53 are dependent on claim 47, that these claims are also allowable in their present form.

Claim 54 stands rejected under 35 USC 103(a) as being unpatentable over Cass in view of LaMarca. Claim 54 is a system claim corresponding to the method claim 47 discussed above. Claim 54 was rejected by the Examiner for the same reasons as claim 47. Claim 54 recites many of the same features as claim 47, modified in respect of the system claims, including

*"causes the list of directory entries and the coded data to be printed onto the surface substantially simultaneously;  
receives indicating data from a sensing device, the indicating data indicative of the identity of a selected user interactive element, the sensing device when placed operatively relative to the selected user interactive element, generating the indicating data based at least partially on sensing at least some of the coded data;"*.

Thus Applicant argues that claim 54 is allowable for the same reasons as claim 47 discussed above. Applicant further submits that as claims 55 to 60 depend on claim 54, that these claims are also allowable in their present form.

#### Claims 34 - 46

Claim 34 stands rejected under 35 USC as being unpatentable over Cass in view of LaMarca and further in view of Dymetman.

As Examiner has stated, claim 34 is of similar scope to claim 47 discussed above. Claim 34 adds, as Examiner has also stated, that the indicating data is indicative of a position of the sensing device relative to the list of directory entries. Examiner has relied on the Dymetman reference for teaching this additional feature. Examiner has quoted sections of Dymetman that Examiner contends demonstrate a motivation for the skilled addressee to combine Dymetman with the other references. However, with utmost respect, Applicant disagrees.

Dymetman in no way describes or suggests a directory navigation system, nor suggests that the interactive paper system of Dymetman would be combinable with a system requiring conventional pen markings to be made, scanned and processed such as taught by Cass. Dymetman is of a similar class of invention as LaMarca, in that both inventions relate to the use of pages having coded data on them. Applicant therefore reiterates Applicant's arguments from above, that these classes of invention, namely Cass on the one hand, and LaMarca/Dymetman on the other, are sufficiently removed from each other, with neither system being considered common general knowledge as at the relevant priority date, that it would not be obvious for the skilled addressee to combine the disclosures in the manner that the Examiner has suggested.

Applicant therefore submits that Dymetman is no more combinable with Cass than the LaMarca reference discussed above, and that accordingly, claim 34 is allowable and that the rejection of claim 34 is hereby traversed.

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As claims 35 to 40 are dependent on claim 34, Applicant submits that these claims are also allowable.

Claim 41 stands rejected on the same grounds as claim 34. Claim 41 is a system claim corresponding to the method claim of claim 34. Accordingly, Applicant contends that the arguments advanced in respect of claim 34 are equally applicable to claim 41, and that accordingly, claim 41 is allowable. Applicant further submits that as claims 42 to 47 are dependent on claim 41, that claims 42 to 47 are also allowable.

#### Summary

In the foregoing, Applicant has highlighted distinctions between the claimed invention and the prior art references. Furthermore, Applicant has advanced reasons why Applicant believes that the person skilled in the art would not be led to combine the references relied on by the Examiner in rejection of the claims. In light of these distinctions and arguments, Applicant submits that all claims pending in the application are allowable.

Applicant further submits that the arguments presented herein are fully responsive to the each of the issues raised in the Official Action. Further consideration of the application is therefore respectfully requested.

Very respectfully,

Applicant:



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